

## REMARKS

This amendment is in response to the Office Action mailed on April 14, 2005 in which claims 1-3, 5, 6, 8-11, 13, 14, and 16-22 were rejected. Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

### **I. Evidence of Secondary Considerations of Nonobviousness to Rebut Rejections Under 35 U.S.C. § 103(a)**

All of the rejections maintained in the Office Action are based on 35 U.S.C. § 103(a). Applicants have addressed each of the rejections separately below, however, Applicants have also provided evidence of nonobviousness which is applicable to all of the rejections.

While Applicants assert that the Examiner has not made a prima facie case of obviousness, Applicants have submitted herewith the declaration under 37 C.F.R. § 1.132 of Corey Maynard. The declaration presents evidence of commercial success in accordance with the requirements of M.P.E.P. § 716.03. The declaration also shows the nexus between the claimed invention and the evidence by comparing the commercial success of the commercial embodiment ("the Nautilus") of the claimed invention to that of the tool ("the Multi-Lite") disclosed in the primary reference, Dallas. It is the Applicant's understanding, based on the Examiner's use of Dallas as the primary reference in all of the rejections, that the Examiner considers Dallas to be the closest prior art of record. The Multi-Lite and the Nautilus have both been manufactured and sold by Gerber Legendary Blades, a subsidiary of the Assignee of both the present application and the Dallas patent.

The basis of the comparison is sales data from the last 12 months during which the Multi-Lite was offered sale and the first 12 months during which the Nautilus was offered for sale. In order to provide the fairest comparison, the 12 month period during which the Multi-Lite was sold are not continuous, because one month was excluded due to abnormally low sales. If this relatively low sales month for the Multi-Lite were included, the commercial success of the Nautilus would be even more significant. The two periods were selected because the Nautilus and the Multi-Lite were not sold contemporaneously (the Multi-Lite was

not offered for sale after July, 2001, and the Nautilus was first sold in April, 2004) and are thus the closest available time frames for comparison. In our view, the periods selected are the best commercially comparable periods to provide a fair comparison of commercial success without presenting any bias in favor of the present invention.

As shown in the attached declaration, sales of the Nautilus exceeded sales of the Multi-Lite by a ratio of more than five to one on a unit basis during the time periods compared. Also, sales of the Nautilus exceeded sales of the Multi-Lite by a ratio of more than six to one on a revenue basis during the same time periods. This success provides a strong indication that the claimed invention is nonobvious.

Applicants have also submitted herewith a copy of a publication praising the claimed features of the Nautilus. The Summer 2004 issue of Outdoor Life included the Nautilus in its “Best Sportsmen’s Innovations of 2004.” The publication specifically points out that “the flashlight snaps up . . . and has two lights, one that points forward so you can find your way, and a second that points toward Nautilus’s tools so you can really see what you’re up to.” This article further shows the commercial success of the Nautilus and the nexus between that success and the claimed invention.

Accordingly, even if the Examiner has set forth a prima facie case of obviousness, the success of the Nautilus compared to that of the Multi-Lite shows that a combination of the Multi-Lite of the primary reference with elements disclosed in the secondary references would not have been obvious to one of ordinary skill in the art.

## **II. Rejection of Claims 1-3, 5 and 6 Under 35 U.S.C. 103(a)**

In section 2 of the Office Action, the Examiner rejected claims 1-3, 5, and 6 as unpatentable over Dallas (5,916,277) in view of Landamia (6,099,141). Applicants respectfully traverse the rejection.

Claim 1 recites an ancillary tool and a flashlight coupled to the same handle, wherein “the first light source lights the ancillary tool when the flashlight is in an open position.” The flashlight disclosed by Landamia does not light a tool that is coupled to a flashlight. The

Examiner states that the light source of Landamia “is capable of lighting the ancillary tool.” However, claim 1 recites that the first light source lights an ancillary tool that is coupled to the handle. In order to establish a prima facie obviousness rejection, each of the claim limitations must be disclosed in the cited art and Applicants respectfully assert that Landamia does not specifically teach lighting an ancillary tool that is coupled to the handle of the Landamia device.

Further, even if all the elements of claim 1 were disclosed by a combination of Dallas and Landamia, neither reference provides a motivation to combine the elements disclosed in Dallas with the elements disclosed in Landamia. The Examiner states that “it would have been obvious to one of ordinary skill in the art, at the time the of the invention, to have provided Dallas with an additional LED light source . . . for additional illumination capabilities.” However, Applicants respectfully assert that neither Dallas, nor Landamia provide such a motivation. Dallas does not teach or suggest a second light source, and as such, does not provide motivation for adding a second light source for additional illumination. Landamia discloses an additional light source, however, Landamia does not do so to provide additional illumination. Rather, the additional light source serves a warning light or beacon. See col. 3, lines 27-30.

Further still, Landamia teaches a flashlight including a support device that is configured to allow the flashlight to be self supporting in hands free use to light a separate ancillary tool. Accordingly, Landamia teaches away from combining the flashlight of Landamia with the handheld tool of Dallas to provide the pocket tool of claim 1 because the pocket tool of claim 1 provides a flashlight and an ancillary tool that are part of a single unit.

Accordingly, claim 1 is patentable over Dallas in view of Landamia. Applicants respectfully request reconsideration and allowance of independent claim 1 and corresponding dependent claims 2-3 and 5-6.

### **III. Rejection of Claims 8, 13, 14, 16 and 17 Under 35 U.S.C. 103(a)**

In section 3 of the Office Action, the Examiner rejected claims 8, 13, 14, and 16 as

unpatentable over Dallas in view of Jones (6,162,137). Applicants respectfully traverse the rejection.

Claim 8 recites “a means for biasing the flashlight into the open position coupled between the handle and the flashlight; and a means for activating the flashlight, wherein when the means for activating the flashlight is engaged, the means for biasing the flashlight moves the flashlight from the closed position to the open position and the flashlight is turned on.” The Examiner contends that Jones discloses such a biasing means and means for activating. However, Jones does not disclose a means for activating the flashlight, “wherein when the means for activating the flashlight is engaged, the means for biasing the flashlight moves the flashlight from the closed position to the open position and the flashlight is turned on.” The Examiner points only to the torsion spring (38) of Jones as a biasing means, but such a structure would not perform the function of the activating means of claim 8. Even if all the elements of the claimed invention were present in the cited references, the Examiner has cited no motivation to combine the references in such a way. Accordingly, the Examiner has not made a prima facie case of obviousness in regards to independent claim 8 and corresponding dependent claims 13, 14, 16, and 17.

Accordingly, claim 8 is patentable over Dallas in view of Jones. Applicants respectfully request reconsideration and allowance of independent claim 8 and corresponding dependent claims 13, 14, 16, and 17.

#### **IV. Rejection of Claims 9 and 10 Under 35 U.S.C. 103(a)**

In section 4 of the Office Action, the Examiner rejected claims 9-10 as unpatentable over Dallas in view of Jones and further in view of Landamia. Applicants respectfully traverse the rejection.

Claims 9 and 10 depend from independent claim 8, and, as stated above, Dallas and Jones do not disclose, either separately or in combination, all of the elements of claim 8. Landamia does not overcome the deficiencies of Dallas and Jones as Landamia does not disclose a means for activating the flashlight, “wherein when the means for activating the

flashlight is engaged, the means for biasing the flashlight moves the flashlight from the closed position to the open position and the flashlight is turned on.” Even if all the elements of the claimed invention were present in the cited references, the Examiner has cited no motivation to combine the references in such a way. Accordingly, the Examiner has not made a prima facie case of obviousness in regards to independent claim 8 and corresponding dependent claims 9 and 10.

Accordingly, claim 8 is patentable over Dallas in view of Jones and further in view of Landamia. Applicants therefore respectfully request reconsideration and allowance of dependent claims 9 and 10.

**V. Rejection of Claims 18-22 Under 35 U.S.C. 103(a)**

In section 4 of the Office Action, the Examiner rejected claims 9-10 as unpatentable over Dallas in view of Landamia and Jones. Applicants respectfully traverse the rejection.

Claim 18 recites “a means for activating the flashlight, wherein when the means for activating the flashlight is engaged, a means for biasing the flashlight moves the flashlight from a closed position to an open position and the flashlight is turned on.” The Examiner contends that Jones discloses such an activating means. However, neither Jones nor Landamia discloses a means for activating the flashlight, “wherein when the means for activating the flashlight is engaged, a means for biasing the flashlight moves the flashlight from a closed position to an open position and the flashlight is turned on.” The Examiner points only to the torsion spring (38) of Jones as a biasing means, but such a structure would not perform the function of the activating means of claim 18. Even if all the elements of the claimed invention were present in the cited references, the Examiner has cited no motivation to combine the references in such a way. Accordingly, the Examiner has not made a prima facie case of obviousness in regards to independent claim 18 and corresponding dependent claims 19-22.

Accordingly, claim 18 is patentable over Dallas in view of Landamia and Jones. Applicants therefore respectfully request reconsideration and allowance of independent claim

18 and corresponding dependent claims 19-22.

## CONCLUSION

Claims 1-3, 5, 6, 8-11, 13, 14, and 16-22 are now pending in this application. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date

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By

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